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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

JEHA et al.

Atty. Ref.: 4398-207

Appl. No. 10/533,940

TC/A.U. Unassigned

Filed: May 4, 2005

Examiner: Unassigned

For: BREATHABLE GAS APPARATUS WITH HUMIDIFIER

* * * * *

May 24, 2006

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. § 1.47(a)

The undersigned hereby responds to the Decision on Response to Notification of Missing Requirements mailed March 16, 2006 and petitions the Commissioner for Patents under 37 C.F.R. § 1.47(a), given that one of the joint inventors in the application, specifically Marek Tomasz Sapula, refuses to join or cannot be found or reached after diligent efforts to obtain his signature.

A response to the Notification of Missing Requirements was due on December 24, 2005. This Petition is being simultaneously filed in conjunction with a Response to Petition that includes a Petition for a five-month extension of time as measured from the December 24, 2005 due date of Notification of Missing Requirements, making the response due on May 24, 2006.

The Petition also includes authorization to charge the fee under 37 C.F.R. § 1.17(h) for filing a

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Petition to the Commissioner, and authorization to charge the surcharge under 37 C.F.R. § 1.492(h) for late filing of the declaration. The undersigned submits that this Petition satisfies all the requirements of 37 C.F.R. § 1.47(a) and respectfully requests that the Petition be granted.

The pertinent section of Rule 47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17, and the last known address of the non-signing inventor. The non-signing inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

37 C.F.R. § 1.47(a). The requirements of that Rule are considered in the present paper as follows:

(A) The signing joint inventors have made a Rule 63 Declaration on their own behalves and on behalf of the nonsigning joint inventor;

(B) Proof that the nonsigning inventor (Marek Sapula) refuses to execute an application for patent, or cannot be round or reached after diligent effort.

(C) The last known address of the nonsigning inventor; and

(D) The fee set forth in 37 C.F.R. § 1.17(g).

(A) The Available Inventors have made declarations on their own behalves and on behalf of the nonsigning joint inventor.

Barton John Kenyon, Arthur Kin-Wai Yee, Rohan Neil Primrose, Jim Saada, John Michael Snow, Geoffrey Crumblin, Duncan Lovel Trevor-Wilson, Perry David Lithgow, Alexander Virr, Donald Angus Richard, Simone Marie Jeha, Andrew Charles Murray and Mark John Payne, the available joint inventors listed in the corresponding International Application (PCT/AU04/00810), have made declarations on their own behalves as required by 37 C.F.R. § 1.63, and have made a declaration on behalf of the nonsigning joint inventor as permitted under 37 C.F.R. § 1.64.

Submitted herewith is a Declaration (37 C.F.R. § 1.63). The Declaration includes signature blocks for all joint inventors named in the application. The Declaration has been executed by the available inventors identified above, and the signature block of Mr. Sapula is left blank.

The applicable section of the M.P.E.P. reads in part:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

M.P.E.P. § 409.03(a). The undersigned therefore submits that, the available joint inventors have executed declaration on their own behalves and on behalf of Mr. Sapula.

(B) Proof that the Nonsigning Inventor Refuses to Sign or Cannot Be Reached after Diligent Effort under 37 C.F.R. §1.47(a)

The undersigned submits that the nonsigning named inventor, Marek Sapula, refuses to sign or cannot be found or reached after diligent efforts to obtain his signature.

For example, a Rule 63 Declaration was posted to Mr. Sapula's home address on March 28, 2006, in relation to the above application. The Rule 63 Declaration posted to Mr. Sapula was a copy of the Rule 63 Declaration attached hereto. To date, an executed Declaration has not been received from Mr. Sapula.

The undersigned therefore submits that a diligent effort has been made to contact each of the inventors, but that Marek Sapula has not executed the application.

(C) The Last Known Addresses of the Nonsigning Inventor

The last known residential address of the nonsigning inventor is as follows:

Marek Tomasz Sapula
Unit 9/29 Brickfield Street
Parramatta, New South Wales 2150
Australia

(D) Statutory Fees Set Forth in 37 C.F.R. § 1.17(h) & § 1.492(e)

Attached is authorization to charge a statutory petition fee of \$130 as set forth in 37 C.F.R. § 1.17(g). Additionally, authorization to charge a statutory fee of \$130 as set forth in 37 C.F.R. §1.492(h) is attached for providing the oath or declaration later than 30 months from the priority date. Payment from a deposit account is authorized via the attached Fee Transmittal.

CONCLUSION

In light of the above facts, the undersigned respectfully requests that the Petition under 35 C.F.R. §1.47(a) be granted and that the enclosed Declaration be accepted as fulfilling all statutory requirements.

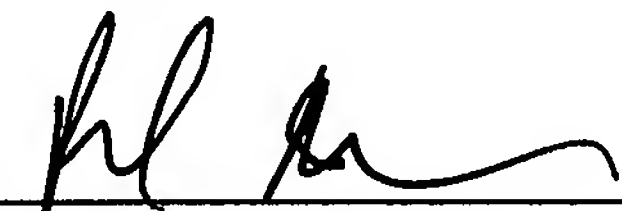
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140** under Order No. 4398-207. A duplicate copy of this paper is attached.

Should the Examiner have any questions regarding the present case, the Examiner should not hesitate to contact the undersigned at the number provided below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

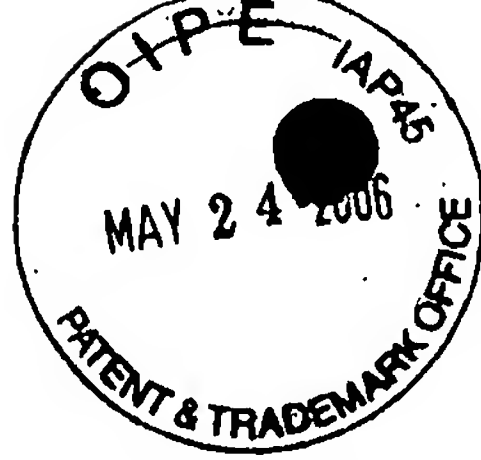
By: _____


Paul T. Bowen
Reg. No. 38,009

PTB:jck
Attachment:
Declaration

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

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May 24, 2006



CONCLUSION

In light of the above facts, the undersigned respectfully requests that the Petition under 35 C.F.R. §1.47(a) be granted and that the enclosed Declaration be accepted as fulfilling all statutory requirements.

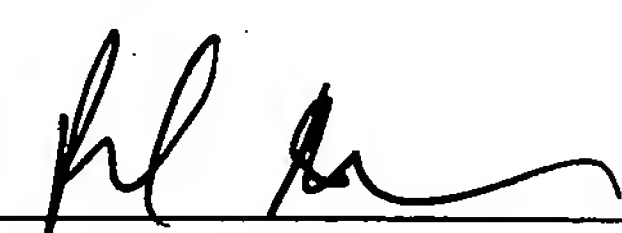
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For: BREATHABLE GAS APPARATUS WITH HUMIDIFIER

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May 24, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RECEIVED
13 JUN 2006
Legal Staff
International Division

RESPONSE TO DECISION ON
RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

In response the Decision rendered 16 March 2006, Applicants request reconsideration in view of the following comments. Petition under 37 C.F.R. 1.136(a) for a five-month extension of time is hereby made to extend the current due date so as to cover the filing date of this paper and attachments.

The Decision indicates that the Rule 63 Declaration filed on 8 July 2005 does not include all of the inventors listed on the published international application (PCT/AU04/00810), and therefore does not meet the requirements of 37 C.F.R. §§ 1.497(a) and (b).

As background, the present application was filed under 35 U.S.C. § 371. The PCT application listed several inventors, including: B. Kenyon, A. Yee, R. Primrose, J. Saada, J. Snow, M. Sapula, G. Crumblin, D. Trevor-Wilson, P. Lithgow, A. Virr, D. Richmond, S. Jeha,

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A. Murray and J. Payne. Inventors Jeha, Murray and Payne were added during the international stage, per Form PCT/IB/306 (copy already provided to the US/RO and referenced in the Decision).

The U.S. National Stage application (U.S. Serial No. 10/533,940) was filed on 4 May 2005 with a Preliminary Amendment in which, *inter alia*, claims 1-91 and 95 were canceled, claim 94 was amended, and claims 96-131 were added. All of the claims in the case, following entry of the Preliminary Amendment, were the claimed subject matter of inventors Jeha, Murray and Payne. None of the other inventors from the International Application contributed to the claimed subject matter remaining in the application.

Upon receipt of the Notification of Missing Requirements dated 24 October 2005, Applicants submitted a copy the fully executed Rule 63 Declaration of the actual inventors of the claimed subject matter, i.e., inventors Jeha, Murray and Payne. The Rule 63 Declaration was previously filed on July 8, 2005. Of note is the fact that the Rule 63 Declaration filed on 8 July 2005 was executed making reference to not only the International Application, but also the Preliminary Amendment of 4 May 2005. These are the only inventors of those identified in the International Application who were entitled to execute the application ("I believe I am an original, first and joint inventor...").

The Decision indicates that the Requirements of 37 CFR 1.497(a) and (b) have not been satisfied, since the Rule 63 Declaration "... does not identify all the inventors listed on the published International application". Applicants respectfully traverse this assertion.

First, Rule 497(a) does not require that all the inventors listed on the published International Application be included on the Declaration. Rule 497(a)(3) states that the declaration "identifies each inventor and the country of citizenship of each inventor." There is

no requirement that the Declaration identify all the inventors listed on the International Application.

Second, Rule 497(a)(4) requires that the oath or declaration state that "... the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors *of the subject matter which is claimed* and for which a patent is sought." (Italics added.) As mentioned above, only inventors Jeha, Murray and Payne are entitled to make this statement, i.e., that they believe they are the original and first inventors of "the subject matter which is claimed, and for which a patent is sought", especially in view of the Preliminary Amendment that is referenced in the Declaration.

Third, Rule 497(b)(1) states that "the oath or declaration must be made by all of the *actual* inventors except as provided in §§1.42, 1.43 or 1.47." Only Jeha, Murray and Payne are "actual" inventors. To require the other inventors to sign this Declaration would require these inventors to make a knowingly false statement.

In view of the above, Applicants respectfully request that the Patent Office issue a Notice of Acceptance of Application.

In the alternative, the Patent Office is requested to consider the attached Rule 63 Declaration which identifies all of the inventors listed in the International Application. Because one of the listed inventors is unavailable or unwilling to sign the enclosed Declaration, a Petition under Rule 47(a) is attached hereto.

Attached is our check in the amount of \$2,420.00 for payment of the Declaration Surcharge Fee \$130.00 (Code 1051), Petition Fee \$130.00 (Code 1464) and Five Month Extension Fee \$2,160.00 (Code 1255). The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should


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have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140** under Order No. 4398-207. A duplicate copy of this paper is attached.

Although this response is being provided with a Petition for a five month extension of time, and fees for the attached Rule 47(a) Petition, Applicants respectfully submit that the filing requirements were satisfied when the Rule 63 Declaration was filed on 8 July 2005, i.e., before the Notification of Missing Requirements was issued on 24 October 2005. Therefore, the Patent Office is requested to waive the requirement for the extension of time and Petition fees, or refund same if already paid by check or deposit account.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Paul T. Bowen
Reg. No. 38,009

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Petition under 37 C.F.R. § 1.47(a)

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Adjustment date: 10/03/2006 SRASHEIR
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